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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,038	03/05/2002	Tecmu Puskala	042933/319824	8149

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EXAMINER
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THOMASSON, MEAGAN J

ART UNIT	PAPER NUMBER
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3714

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/091,038

Applicant(s)

PUSKALA, TEEMU

Examiner

Meagan Thomasson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 1, 2007 has been entered.

### ***Response to Amendment***

The examiner acknowledges the amendments made to claims 1,16,31,43 and 46. Claim 13 has been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,16,31,43 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the independent claims have been amended to include the limitation of "at least one content-related predefined message to the user of the at least one wireless terminal **based upon the certain**

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content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content" (emphasis added). It is unclear to the examiner how the message may be simultaneously based upon the certain content and independent of said content. This language renders the claim indefinite, as the examiner cannot determine whether the predefined messages are either based upon the content or independent of the content.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-12,14-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 6,908,389.** Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent No. 6,908,389 (herein

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referred to as '389) are substantially similar to those of the instant application in that they comprise a system and method for enhancing communication on a wireless network using predefined messages comprising a service platform, transmitting means for transmitting certain content to a user of a wireless terminal, providing means for providing at least one content-related predefined message to the user of the wireless terminal, at least one wireless terminal for receiving the certain content and the at least one content-related predefined message, selecting means for enabling the user of the wireless terminal to transmit the content-related predefined message, and transmitting means for transmitting the content-related predefined message to at least one address selectable by the user.

The conflicting claims are not identical in that the claims of '398 are drawn to providing gaming content, while the claims of the instant application are drawn to providing "certain content", as recited in claim 1. The scope of the claims in the instant application encompasses the gaming content of '398, and thus the claims are not patentably distinct.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Sivula (US 6,795,711 B1).**

Regarding claims 1,16,41-46,49 Sivula discloses a system for enhancing communication on a wireless network using predefined messages comprising a service platform running an online service, the online service for providing a certain content (referred to by Sivula as the Special Application Service Center in Fig. 3 and the description thereof, col. 7, line 57 – col. 8, line 51), the service platform comprising transmitting means for transmitting the certain content to a user of at least one wireless terminal and providing means for providing along with the transmitting certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being automatically modified based on an identity of the certain content.

Specifically, Sivula discloses a system for enabling communication between wireless phone users such that if a wireless phone originating station chooses to send a special content message to a terminating wireless phone, a short descriptive message is provided to the user of the terminating wireless phone describing the incoming special

content message. If the terminating phone has the capability to receive the special content message, the special content message is transmitted to and displayed on the terminating wireless phone (as shown in Fig. 3). The content-related predefined message provides a description of the content as well as the requirements necessary to process the incoming content (col. 6, lines 34-61). Further, Sivula discloses that the content and related short messages may be predefined (col. 8, lines 28-44) as they may be stored on a central server and accessed by an originating wireless phone.

Sivula discloses the originating wireless phone comprises selecting means for enabling selecting by the user of said wireless phone whether to transmit the content and predefined message from said wireless terminal as well as transmitting means for transmitting the content and related pre-defined message to at least one address selectable by the user of said at least one wireless terminal (col. 6, lines 20-27).

Regarding claims 2-4, 17-20 wherein the at least one address selectable by the user comprises a predetermined address of at least one other wireless terminal, the invention disclosed by Sivula features wireless phones such that a user may select or enter the telephone number, i.e. address, of the intended recipient.

Regarding claims 5, 21, the at least one other terminal comprises a wireless terminal (abstract).

Regarding claims 6, 22, 32 Sivula discloses means for assessing an output capability of said at least one other terminal to receive the predefined message, and means for configuring the predefined message, prior to transmitting the predefined message to the address of the at least one other terminal, so that the output capability

of the at least one other terminal to receive the predefined message is taken into consideration (col. 9, lines 46-57).

Regarding claims 7,23,47 Sivula discloses the providing means comprises a content determining means for determining the content of the online service (col. 9, lines 45-47).

Regarding claims 8,24 Sivula discloses said providing means receives a predefined criteria and generates or selects the predefined message based upon the predefined criteria. That is, Sivula discloses the name of the message may be generated in a manner that indicates to the recipient the requirements, i.e. criteria, necessary to process the content message (col. 6, lines 59-61).

Regarding claims 9,25,34 Sivula discloses both terminals are mobile phones (abstract).

Regarding claims 10,35 wherein the at least one wireless terminal comprises a dedicated button to cause the content-related predefined message to be transmitted to the selected address, the "Send" button on any cellular phone acts as a dedicated button to begin a transmission.

Regarding claims 11,26 Sivula discloses an indicator to be displayed to indicate that at least one content-related predefined message is available for selection (col. 10, lines 8-12).

Regarding claims 12,27 Sivula discloses the content-related predefined message comprises an automated message that is sent automatically to the at least one address



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when at least one condition of the certain content matches any of a predefined criteria (col. 6, line 49-col.7, line 7).

Regarding claims 14,28 Sivula discloses the predefined message is stored in and retrieved by the providing means from a storage device in the service platform (col. 8, lines 28-44).

Regarding claims 15,30,38 Sivula discloses the predefined message comprises at least one of voice, text, sound, an image, a picture and a video (col. 6, lines 50-55).

Regarding claims 39,40 wherein the on-line service comprises at least one of an Internet web site and a network server providing at least one of an interactive program and streaming audio and/or video (col. 6, lines 15-20).

Regarding claim 31, in addition to the invention described above, Sivula discloses the wireless terminal comprises a processor in communication with a data storage device, a primary input in communication with the processor, and an interactive program operative on the processor (col. 9, lines 15-22).

Regarding claim 33,47 Sivula discloses the wireless terminal comprises input means for receiving certain content from an on-line service (Fig. 5, Means for Receiving SMS or S.A.), wherein the interactive program is further operative for determining whether the certain content of the on-line service has at least one condition matching any of the at least one content-related predefined criteria (col. 9, lines 45-58).

Regarding claims 36 and 37, Sivula discloses the storage device may be located in the wireless terminal (col. 9, lines 15-20) as well as located in a service platform (col. 8, lines 28-44).

Regarding claims 48 and 50, Sivula discloses the service platform has a communication link with the content provider (Fig. 1 and 3).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Robert E Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714

Meagan Thomasson  
June 28, 2007